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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,237	07/29/2003	Francis J. DiSalvo JR.	C1134.70003US00	8278
7590	09/20/2007	Rober H. Walat Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210	EXAMINER LEWIS, BEN	
			ART UNIT 1745	PAPER NUMBER
			MAIL DATE 09/20/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/630,237	DISALVO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ben Lewis	1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,7,13 and 91-96 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1,7,13 and 91-96 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/25/07</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 25<sup>th</sup>, 2007 has been entered. Claims 2-6, 8-12 and 14-90 were cancelled.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lukehart et al. (U.S. Patent No. 6,232,264 B1).

With respect to claims 1, 7, 92 and 93, Lukehart et al disclose polometallic precursors wherein the invention includes a fuel cell catalyst composition which comprises a supported nanocomposite (Col 6 lines 65-67). The nanoparticles in the nanocomposite of the present invention are preferably substantially formed of, and more preferably virtually solely formed of the crystalline alloy "ordered" form of the first metal and the second metal. By way of example, such crystalline alloy forms would include PtRu, PtSn, Pt<sub>2</sub>W, Pt<sub>3</sub>Sn, Pt<sub>3</sub>Ru, Pt<sub>3</sub>Mo, RuMo, mixtures of various of these forms with PtP<sub>2</sub>, and various other stoichiometric combinations of core metals of the precursors described herein (Col 20 lines 25-35).

Lukehart et al teach that such carbon-supported nanoparticles, particularly platinum and platinum-rich alloy nanoparticles, such as platinum-ruthenium, are useful fuel cell catalysts. Catalysts that have been studied include PtRu, Pt<sub>3</sub>Ru, and PtPb. These catalysts have also been investigated for use as anode catalysts in fuel cells (Col 4 lines 20-30).

Lukehart et al teach that the composition may be formed into an electrode, such as an anode or cathode, for use in a fuel cell such as a DMFC by standard methods using standard ink electrode technology. When methanol is added to the fuel cell and contacts the electrode in the presence of oxygen, the oxidation of methanol is catalyzed by the nanoparticles and electrons extracted from methanol can be passed through the conductive connection of the particles to the support, and through the support to an external circuit, whereby direct current may be generated (Col 20 lines 25-35).

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With respect to claim 13, Lukehart et al teach that the nanoparticles in the nanocomposite of the present invention are preferably substantially formed of, and more preferably virtually solely formed of the crystalline alloy “ordered” form of the first metal and the second metal. By way of example, such crystalline alloy forms would include PtRu, PtSn, Pt<sub>2</sub>W, Pt<sub>3</sub>Sn, Pt<sub>3</sub>Ru, Pt<sub>3</sub>Mo, RuMo, mixtures of various of these forms with PtP<sub>2</sub>, and various other stoichiometric combinations of core metals of the precursors described herein (Col 20 lines 25-35). Lukehart et al also teach that the first metal is preferably a noble metal such as platinum, palladium, gold, or any other transition metal or Lanthanide metal. The at least one second metal may be any of the metals acceptable for the at least one first metal including metals from Groups 13-16, like tin. (Col 4 lines 20-30)

The instant specification recites: The invention provides a catalyst that comprises an ordered intermetallic compound and is designed for use in a catalytic system. In some embodiments, the catalyst may comprise an ordered platinum intermetallic compound, such as BiPt, Bi<sub>2</sub>Pt, PtIn, PtPb, PtGe, PtIn<sub>2</sub>, PtIn<sub>3</sub>, Pt<sub>3</sub>In<sub>7</sub>, PtSn, PtSn<sub>2</sub>, Pt<sub>3</sub>Sn, t<sub>2</sub>Sn<sub>3</sub>, PtSn<sub>4</sub>, PtSb, PtSb<sub>2</sub>, PtGa, PtCd<sub>2</sub>, and PtMn. In some embodiments, the catalyst may comprise an ordered palladium intermetallic compound (Paragraph 0011).

Lukehart et al do not specifically teach wherein the ordered intermetallic compound has an interatomic nearest neighbor distances of greater than at least 3.0 Angstroms along at least one axis. However, it is the position of the examiner that such properties are inherent, given that Lukehart et al and the present application utilize the same elements which are both made in a crystalline “ordered” form. A reference which

is silent about a claimed invention's features is inherently anticipatory if the missing feature is necessarily present in that which is described in the reference. In re Robertson, 49 USPQ2d 1949 (1999).

With respect to claim 91, Lukehart et al. teach that metal/carbon nanocomposites of commercial importance were prepared in less than one minute of reaction time by microwave irradiation of conductive carbon powder supported metallic or polynanomaterialic precursors. Pd or Pt halide complexes were used as precursors for nanoparticles comprising those metals, while a non-cluster-type Pt--Ru bimetallic precursor was used as a single-source precursor to generate nanoparticles "powder" having the composition Pt<sub>1</sub>Ru<sub>1</sub>. Average metal particle sizes for these Pd, Pt, and Pt<sub>1</sub>Ru<sub>1</sub> nanoparticles were 7.0, 5.3, and 2.8 nm, respectively by TEM (Col 32 lines 25-41).

### **Claim Rejections - 35 USC § 103**

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 94 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lukehart et al. (U.S. Patent No. 6,232,264 B1) as applied to claim 1 above and further in view of Acker et al. (U.S. Patent No. 2002/0102451A1).

With respect to claims 94 and 96, Lukehart et al disclose polymetallic precursors wherein the invention includes a fuel cell catalyst composition which comprises a supported nanocomposite in paragraph 2 above. Lukehart et al do not specifically teach wherein the fuel is ethanol or ethylene glycol. However, Acker et al. disclose a fuel cell wherein the anode catalyst layer 42 includes high surface area catalytic alloy particles, such as platinum particles (Pt) or a mixture of platinum and ruthenium alloy particles (Pt/Ru). The electrocatalytic particles are loaded onto either the anode gas diffusion layer 44 or the membrane electrolyte 80 to act as an electrocatalyst. The Pt/Ru alloy particles are well known in the art and provided either as "unsupported" particles in the form of a fine metal powder, or "supported" particles. The "supported" particles include electrocatalyst particles dispersed on high surface area particles (Paragraph 0051). Acker et al. also teach that methanol may be supplied to the fuel cell system 10 as a vapor or a direct feed liquid stream of either neat methanol or a solution of methanol and water. Other hydrocarbon fuels may be used with the fuel cell system 10 of the invention, such as, although not limited to, ethanol, ethylene glycol, supplied to the fuel cell system 10 in either vapor or liquid state (Paragraph 0047). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use ethanol and ethylene glycol of Acker et al. in the fuel cell of Lukehart et al.

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because it would be economically and operationally beneficial to use different fuels to generate electricity.

5. Claim 95 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lukehart et al. (U.S. Patent No. 6,232,264 B1) as applied to claim 1 above and further in view of Qi et al. (U.S. Patent No. 7,141,322 B2).

With respect to claims 95, Lukehart et al disclose polynmetallic precursors wherein the invention includes a fuel cell catalyst composition which comprises a supported nanocomposite in paragraph 2 above. Lukehart et al do not specifically teach wherein the fuel is formic acid. However, Qi et al. disclose a fuel cell wherein Pt/Ru and Pt blacks were used as the anode and cathode catalysts, and they were applied to Teflon.RTM.-treated 6- and 9-mil Toray paper, respectively, in order to achieve electrodes with Pt/Ru and Pt (Col 4 lines 44-55). Qi et al. also teach that for fuel cells comprising a formic acid and methanol/water solution for the conduction of protons within the anode structure, formic acid appeared to improve ionic conductivity and was clean burning. Furthermore, it did not poison the catalysts (Col 2 lines 10-20). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the formic acid fuel of Qi et al. into the fuel cell of Lukehart et al. because Qi et al. teach that formic acid appeared to improve ionic conductivity and was clean burning. Furthermore, it did not poison the catalysts (Col 2 lines 10-20).

***Response to Arguments***

6. Applicant's arguments filed on June 25<sup>th</sup>, 2007 have been fully considered but they are not persuasive.

*Applicant's principal arguments are*

(a) Independent claim 1 is directed to a catalyst that comprises a specific ordered intermetallic compound - PtPb. The Office Action relies on description in the "Background of Invention" in the Lukehart patent which refers to previous work that studied PtPb as a catalyst and cites a number of references (column 4, lines 23-27). After studying the Lukehart patent and these references<sup>2</sup>, Applicant concluded that "PtPb" in this text was a typographical error that should have read "PtPd". Applicant contacted Professor Charles Lukehart (inventor from the Lukehart patent) and Vanderbilt University (assignee of the Lukehart patent) to discuss this issue. Professor Lukehart confirmed that the use of "PtPb" was a typographical error and that the text should have read "PtPd". A Certificate of Correction has been filed in connection with the Lukehart patent to correct this typographical error. Applicant is enclosing a copy of this Certificate of Correction with this response. In view of the previous remarks, the Lukehart patent fails to teach using PtPb in any form as a catalyst, much less using an ordered intermetallic PtPb in a system that oxidizes a fuel selected from the group consisting of formic acid, methanol, ethanol and ethylene glycol as claimed. Because

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each claim limitation is not taught or suggested by the Lukehart patent, claim 1 is novel in view of this reference.

In response to Applicant's arguments, please consider the following comments.

(a) The Journal article of Hamnett which was referenced by the applied prior art (Lukehart) teaches that lead is known as a material to be used with surface modified platinum electrodes in which atoms of Pb are present (pg. 1613).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ben Lewis whose telephone number is 571-272-6481. The examiner can normally be reached on 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ben Lewis

  
PATENT  
SUPERVISORY PATENT EXAMINER

Patent Examiner  
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